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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/788,639	02/21/2001	Roger Berger	8932-320	7055
20582	7590	10/03/2003	EXAMINER	
PENNIE & EDMONDS LLP 1667 K STREET NW SUITE 1000 WASHINGTON, DC 20006			ODLAND, KATHRYN P	
			ART UNIT	PAPER NUMBER
			3743	

DATE MAILED: 10/03/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/788,639

Applicant(s)

BERGER, ROGER

Examiner

Kathryn Odland

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 12-23 is/are rejected.
- 7) ☒ Claim(s) 8-11 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 11, 12.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

Second and Third Information Disclosures have appeared with the case and have been considered. However, there does not appear to be a First Information Disclosure, although it seems that one was provided. It is requested that the First Information Disclosure that it is resubmitted, for the paper does not appear in the file.

Specification

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

A novel feature of the invention should be included in the title.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-7 and 12-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Farris et al. in US Patent No. 6,485,491.

Regarding claim 1, Farris et al. disclose an occipital plate (such as 130) having a front side and a back side, a central portion, two leg portions (generally 134, 136), and a plurality of bone screw holes (142) in the central portion, the holes *being configured and dimensioned to receive a bushing* and at least one clamping portion (such as 22, 162,

etc.) disposed on the front side proximate a free end of at least one of the leg portions, wherein the plate is bendable to conform to an occiput, as recited in column 7, lines 65-67 and column 8 as well as seen in figures 19-22. The phrase, "*being configured and dimensioned to receive a bushing*" is considered functional language given that a bushing is not positively recited. Therefore, given the structure of the hole of Farris et al. it is capable of incorporating a bushing. Furthermore, the phrase, 'wherein the plate is bendable to conform to an occiput' is also considered functional language that is considered to be "[l]anguage that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure [and therefore] does not limit the scope of a claim or claim citation" (See M.P.E.P. 2106, page 2100-8, Rev. 2, July 1996). Functional language does not hold patentable weight in apparatus claims and it has been held that the functional "whereby" and "wherein statement do not defined any structure and accordingly cannot serve to distinguish. In *Re Mason*, 114 USPQ 127, 44 CCPA 937 (1957). Moreover, the plate of Farris et al. can be considered bendable, given a reasonably broad interpretation of the claim, any material has some degree of bendability and the specification does not discuss the scope of the term bendable. Additionally, Ferris et al. disclose in column 8, lines 24-30 that the plate is to be shaped for the occipital bone.

However, Farris et al. do not explicitly recite, a Y-shaped plate portion. On the other hand, it would be obvious to one with ordinary skill in the art to modify the plate of Farris et al. to be Y-shaped or any other shape for the specification of the current application does not demonstrate the criticality for a Y-shape.

Regarding claim 2, Farris et al. do recite a central portion that has an upper portion, a lower portion and an upper portion having one bone screw hole, as seen in figure 19. However, Farris et al. do not explicitly recite a central portion that includes a grooved portion therebetween. On the other hand, it is well known in the art to score or provide a groove or channel when desiring to enhance bendability. Therefore, it would be obvious to one with ordinary skill in the art to modify the invention of Farris et al. to include a grooved portion for the purpose of enhancing bendability.

Regarding claim 3, Farris et al. further do not recite a grooved portion that is flexible to permit the upper portion to be disposed at an angle with respect to the lower portion. Again, it would be obvious to one with ordinary skill in the art to provide a grooved portion in the system of Farris et al. to enhance bendability.

Regarding claim 4, Farris et al. recite leg portions and at least a portion of the central portion that are disposed in nonparallel planes, as seen in figure 20.

Regarding claim, 5 although Farris et al. do not explicitly recite planes that intersect at an angle of between about 160.degree. and about 175.degree, given figure 20 the angle shown falls within the scope of the invention.

Regarding claim, 5 although Farris et al. do not explicitly recite planes intersect at an angle of about 170.degree, given figure 20 the angle shown falls within the scope of the invention.

Regarding claim 7, Farris et al. recite a clamping portion that has a pivot member (such as via 176 with 160) and a clamp plate (168), the clamp plate being pivotable about the pivot member, as seen in figure 24.

Regarding claim 12, Farris et al. disclose a leg portion that additionally has a rod-receiving first recess and the clamping plate additionally having a rod-receiving second recess, the first and second recesses generally opposing each other, as seen in figures 19-22.

Regarding claim 13, Farris et al. disclose a second recess is serrated, as seen in figures 19-22 (wherein the threads can be considered serrations).

Regarding claim 14 although Farris et al. do not explicitly recite bone screw holes in the lower portion that are disposed in a rectangular array, it would be obvious to one with ordinary skill in the art to have the holes in a rectangular array or any configuration that properly secures. Additionally, the current application specification does not recite the criticality of a rectangular array and further shows other configurations in the figures.

Regarding claim 15, Farris et al. disclose at least one group of bone screw holes in an array that are disposed along a central axis of the plate extending between the leg portions, as seen in figure 19.

Regarding claim 16, Farris et al. disclose a bone screw hole in the upper portion is disposed on the central axis, as seen in figure 19.

Regarding claim 17, Farris et al. disclose at least two bone screw holes are disposed coaxially, as seen in figure 19.

Regarding claim 18, bushings that permit polyaxial angulation would be obvious to one with ordinary skill in the art when modifying the invention to provide bushings.

Regarding claim 19, Farris et al. disclose a plate that is bendable along at least two generally parallel axes, as seen in figure 20 (and wherein most materials are bendable in multiple axes).

Regarding claim 20, Farris et al. a plate that is bendable along at least two generally perpendicular axes, as seen in figure 20 (and wherein most materials are bendable in multiple axes).

Regarding claim 21, Farris et al. disclose an occipitocervical fixation system having an occipital plate (such as 130) having at least one rod clamp portion (such as 162, 22, etc.) and a plate portion with at least one hole (142) for receiving a bone screw (24b); at least one bone screw (24b); and at least one rod (36), wherein the rod is retained between the plate portion, as recited throughout the specification and seen in figures 1 and 19-22.

However, Farris et al. do not explicitly recite a rod clamp portion having a post, a clamp plate with a hole for receiving the post, and a fastener for tightening the clamp to the post and the clamp plate and is pivotable about the post. Although, the assembly of Farris et al. is shown integral, it would be obvious to one with ordinary skill in the art to make the system separable and pivotable for the purpose of increasing flexibility of the system.

4. Claims 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Asher et al. in US Patent No. 4,773,402.

Regarding claim 22, Asher et al. discloses a pre-bent rod (such as 29) for attachment to an occipital plate (such as 27) having a straight section, a bent section and a serrated clamping section (69). However, Asher et al. do not explicitly recite a straight section and serrated clamping section are disposed substantially perpendicular to each other, and the clamping section and the bent section are disposed at an angle of about 45.degree. with respect to each other. On the other hand, it would be obvious to one

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with ordinary skill in the art to bend the rod in any manner that provides for securement.

Additionally, the specification for the current application does not recited the criticality for the specific angles.

Regarding claim 23, a serrated clamping section that is generally cylindrical and has circumferential serrations about an angular range of between about 90.degree. and 180.degree. again would be obvious to one with ordinary skill in the art for the specification of the current application does not demonstrate the criticality for the specified angles.

Allowable Subject Matter

5. Claims 8-11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as follows: US Patent No. 6,613,050; US Patent No. 6,524,615; US Patent No. 6,235,033; US Patent No. 6,146,382; US Patent No. 5,889,903; US Patent No. 5,704,936; and US Patent No.5,653,708.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathryn Odland whose telephone number is (703) 306-3454. The examiner can normally be reached on M-F (7:30-5:00) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry A Bennett can be reached on (703) 308-0101. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

KO



Henry Bennett
Supervisory Patent Examiner
Group 3700